REMARKS/ARGUMENTS

I.   Status of the Application

Prior to the entry of this Amendment, claims 1-17 were pending in this application. An office action mailed March 5, 2007 rejected claims 1-17 under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement. The office action further rejected claims 1, 11-14 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,970,842 to Ashby (hereinafter, "Ashby"), in view of User's Guide for Microsoft Project for Window 95 and Windows 3.1 (hereinafter, "Microsoft"). The office action rejected claims 2-5 under § 103(a) as being unpatentable over Ashby and Microsoft, in further view of U.S. Patent No. 6,584,466 to Serbinis et al. (hereinafter, "Serbinis"); rejected claims 6-10 under § 103(a) as being unpatentable over Ashby, Microsoft and Serbinis, in further view of U.S. Patent No. 6,434,580 to Takano et al. (hereinafter, "Takano"); and rejected claim 15 under § 103(a) as being unpatentable over Ashby and Microsoft, in further view of U.S. Patent No. 6, 918, 082 to Gross et al. (hereinafter, "Gross").

Claims 1, 13 and 14 have been amended herein, but no claims have been added or canceled. Therefore, claims 1-17 remain pending in this application. Claims 1, 13 and 14 are independent claims. Applicant respectfully requests reconsideration of this application for at least the reasons presented below.

II.   Claim Amendments

Claim 1 has been amended to recite, inter alia, that "said first workflow rule defines a workflow," as well as to recite "tracking one or more elapsed times selected from the group consisting of a time elapsed from a beginning of the workflow, a time elapsed during performance of each of one or more tasks of the workflow, and a time elapsed between performance of each of one or more tasks of the workflow." Support for this amendment can be found throughout the application, including, inter alia, in ¶ 0042-43 of the specification. Claims

13 and 14 have been amended in somewhat similar fashion. Claim 1 also has been amended to replace the phrase "approval to" with the phrase "approval from." It is submitted that these amendments do not narrow the scope of the claims.

III.   Rejections under 35 U.S.C. § 112

The office action rejected claims 1-17 under § 112, ¶ 1 as failing to comply with the written description requirement. Specifically, the office action asserted that claims 1, 13 and 14 recited "tracking a time elapsed from receipt of the first signal indicating a request to submit a patent application for approval and a time elapsed from communicating said message requesting comments on said draft patent application from said second client system."

As an initial matter, the applicant notes that, while claim 1 did recite this element, neither claims 13 nor 14 included the element quoted by the office action, although they did include somewhat similar elements. The applicant also disagrees with the position of the office action, that the element finds no support in the application as filed. However, in the interest of expediting examination, claim 1 has been amended to recite "tracking one or more elapsed times selected from the group consisting of a time elapsed from a beginning of the workflow, a time elapsed during performance of each of one or more tasks of the workflow, and a time elapsed between performance of each of one or more tasks of the workflow." As noted above, it is believed that this element finds support throughout the application, including specifically in ¶ 0043. Claims 13 and 14 have been amended in similar fashion.

It is respectfully submitted that the § 112, ¶ 1 rejections of claims 1-17, to the extent they had merit, have been overcome by these amendments, and reconsideration of the rejections is respectfully requested.

IV.   Rejections under 35 U.S.C. § 103

The office action rejected claims 1-17 under § 103(a) as being unpatentable over Ashby and Microsoft, taken in some cases, with additional references. It is submitted however, that the combination of Ashby and Microsoft fails to create a prima facie case that even independent claims 1, 13 and 14 are unpatentable, and that the other cited references fail to

supplement the disclosure missing from Ashby and Microsoft. Accordingly, it is believed that all of the claims are allowable over the cited combinations of references.

As an initial matter, it is submitted that Ashby is not prior art with respect to at least some of the pending claims. This application was filed November 27, 2001, and it claims priority from provisional U.S. Application No. 60/253,360 (the "Provisional Application"), which was filed November 27, 2000. Ashby, on the other hand, was not filed until June 29, 2001. Hence, to the extent any pending claim is entitled to the priority of the Provisional Application, Ashby can be removed as prior art. (It is worth noting that Ashby claims priority to provisional U.S. Application No. 60/190,824 (the "Ashby Provisional"), which was filed before the Provisional Application. However, a review of the Ashby Provisional reveals no relevant disclosure that would entitle Ashby to the priority date of that application, for purposes of evaluating the present claims.)

It is submitted that at least some of the pending claims are entitled to the priority date of the Provisional Application. For example, claim 14 recites substantially the same elements as claim 1 of the Provisional Application, with the exception of element (iv) and a portion of element (i), which are believed to be supported, inter alia, by page 10, line 23 – page 11, line 16, and page 18, lines 1-12, of the Provisional Application. (It is believed that the Examiner has access to the Provisional Application and can verify this support herself. If, however, the Examiner would like a copy of the Provisional Application, she is invited to contact the undersigned, who would be happy to furnish a copy.) Accordingly, claim 14 is believed to be entitled to the filing date of the provisional application, and Ashby therefore is not prior art with respect to claim 14. (The Provisional Application similarly is believed to provide support for various other pending claims as well.)

For those claims that are supported by the Provisional Application, including in particular, claim 14, the rejections under § 103(a) are infirm insofar as those rejections rely upon Ashby.

Moreover, even to the extent that Ashby can be considered prior art, the office action does not establish a prima facie case that any claim is unpatentable over the combination

of Ashby and Microsoft. To establish a prima facie case that a claim is unpatentable over a

combination of references, an office action might show, inter alia, a teaching or suggestion in the

cited prior art of each claimed limitation. *See* MPEP § 2143. The combination of Ashby and

Microsoft fails to teach or suggest each element of any pending claim.

> Consider, for example, claim 1, which recites, inter alia, "storing a first workflow

rule on a server system, wherein said first workflow rule implements a workflow that causes,

upon receipt of a first signal indicating a request to submit an invention disclosure for approval,

the server system to generate a message that requests approval to prepare a patent application for

said invention disclosure and route said message to a second client system based on the first

workflow rule." The office action cites column 4, lines 35-55 of Ashby as disclosing this

element. That passage states, in its entirety,

> The communication structure includes a notification structure 64 that distributes
> information to the users regarding certain tasks, accomplishments and upcoming
> due dates. For example, the project personnel may be notified by e-mail when a
> date deadline is approaching, or when an action has been authorized or
> completed. In one aspect, a working group calendar is updated. In another
> aspect, certain personnel are notified depending on their attributes such as
> position, group or access level, for example, the client is notified of a request for
> approval. The communication structure also includes an electronic filing structure
> 66 allows the users to file documents with other computer systems, for example,
> government agencies and record the actions. The memory stores information
> related to the communication including attributes associated with the filed
> document. The attributes include a date stamp, which may include the time as
> well. Other attributes include the party or parties to whom the communication is
> made and other information. Additionally, an approval structure 68 allows the
> client has the ability to authorize certain activities such as the filing of patent
> applications in specific countries, etc.

Ashby, c. 4, ll. 35-55.

> At most, this passage teaches the concept of sending a message for an

approaching deadline and, separately, an approval structure for approving a foreign filing of a

patent application. It does not, however, even teach or suggest the concept of sending a message

in connection with an approval, let alone any of the elements recited by claim 1.

> Specifically, contrary to the position taken by the office action, this disclosure

does not teach or suggest a workflow rule that defines a workflow. Nothing in this disclosure

reasonably can be considered a "workflow rule," let alone the type of workflow rule recited by

claim 1, which requires the workflow rule to "define[] a workflow that causes, upon receipt of a

first signal indicating a request to submit an invention disclosure for approval, the server system to generate a message that requests approval to prepare a patent application for said invention disclosure and route said message to a second client system based on the first workflow rule."

Claim 1 also recites "storing a first invention disclosure in a database accessible by said server system." The office action cites Figure 9 of Ashby as teaching this element, presumably because Figure 9 includes a data field that has a value of "Patent Application" with a label of "Project Type." In fact, however, this data field utterly fails to teach or suggest storing an invention disclosure in a database accessible by a server system. The office action recognizes this implicitly by reinterpreting the claim language to recite "storing a first invention disclosure/patent application in a database accessible by said server system." Office Action, at 5. Even so misconstrued, however, this element is neither taught nor suggested by a mere screen shot indicating that Ashby's system might support a project of type "patent application." Moreover, there is a material difference between an invention disclosure and a patent application, and the office action completely disregards this difference.

Claim 1 further recites "receiving, at said server system, a first signal from a first client system indicating a request to submit said first invention disclosure for approval." The office action cites column 4, lines 53-55 of Ashby (quoted above) as teaching this element. While Ashby does disclose, in general, the concept of approvals, the office action identifies nothing in Ashby that teaches or suggests "receiving a first signal from a first client system indicating a request to submit said first invention disclosure for approval," as recited by claim 1. Nowhere in the cited passage is there any disclosure that a server receives any kind of request at all.

Finally, claim 1 recites "executing said workflow rule from said server system to generate a message requesting approval from said second client system to prepare a patent application from said first invention disclosure and to communicate said message to said second client system." The office action cites column 8, line 9 through column 9, line 6 and Figures 13-15 of Ashby as teaching this element. The cited passage, however, provides no disclosure of executing a workflow rule – instead, it merely describes interfaces that can be used, manually, by a user to view projects (and, in one case, approve filing of a PCT application).

Hence, viewed in toto, the cited portions of Ashby fail to disclose virtually any of the elements of claim 1 for which they are cited. Specifically, these cited portions of Ashby fail to disclose at least the following elements:

- storing a workflow rule that defines a workflow
- storing an invention disclosure
- receiving a signal indicating a request to submit an invention disclosure for approval
- executing a workflow to generate a message requesting approval from a client system to prepare a patent application from the invention disclosure.

The office action attempts to avoid the material differences between claim 1 and Ashby by dismissing them as irrelevant: "[T]he differences in the types of documents of data in the messages are only found in the non-functional descriptive material which is not functionally involved in the steps recited [nor] does this data alter the recited structural elements of the system. . . . The recited method steps would be performed the same regardless of the data." Office Action at 7. In short, the office action disregards the entire nature of the invention recited by claim 1.

It is respectfully submitted that this rationale is a misstatement of the law and also evidences a misunderstanding of the claimed invention. Under this rationale, any reference that disclosed a workflow of storing a document (of any type) and sending a message (of any type) likely would anticipate claim 1. That is simply not the case. For example, the office action relies on *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994) as supporting this view. In fact, *Lowry* held just the opposite:

> Contrary to the PTO's assertion, Lowry does not claim merely the information content of a memory. Lowry's data structures, while including data resident in a database, depend only functionally on information content. While the information content affects the exact sequence of bits stored in accordance with Lowry's data structures, the claims require specific electronic structural elements which impart a physical organization on the information stored in memory. . . .
>
> . . .
>
> Lowry's claimed invention involves an organization of information and its interrelationships which Kumpati neither discloses nor suggests. Kumpati also does not render Lowry's claims obvious. The Board erred in holding otherwise.

32 F.3d at 1583-84. As the Federal Circuit taught in *Lowry*, if there is a functional relationship

between data and the structural elements of a claim, that relationship can create a patentable

distinction. Similarly, the other case cited by the office action, *In re Gulack*, 703 F.2d 1381

(Fed. Cir. 1983) expressly found that a functional relationship between printed matter and a

substrate created a patentable difference between the rejected claims and the cited prior art. *See*

703 F.2d at 1386-87. The office action's citation of MPEP § 2106 is no more persuasive: that

section (which is titled, "Patentable Subject Matter Eligibility") deals primarily with how to

analyze a computer-related invention under 35 U.S.C. § 101 to determine whether a claim recites

statutory subject material. The only comment in § 2106 that deals with 35 U.S.C. § 103 states,

> Reviewing a claimed invention for compliance with 35 U.S.C. 102 and 103
> begins with a comparison of the claimed subject matter to what is known in the
> prior art. See MPEP § 2131 - § 2146 for specific guidance on patentability
> determinations under 35 U.S.C. § 102 and 103. If no differences are found
> between the claimed invention and the prior art, then the claimed invention lacks
> novelty and is to be rejected by USPTO personnel under 35 U.S.C. 102. Once
> differences are identified between the claimed invention and the prior art, those
> differences must be assessed and resolved in light of the knowledge possessed
> by a person of ordinary skill in the art. Against this backdrop, one must determine
> whether the invention would have been obvious at the time the invention was
> made. If not, the claimed invention satisfies 35 U.S.C. 103.

MPEP § 2106. This section, contrary to the assertion of the office action, does not support the

proposition that "descriptive material will not distinguish the claimed invention form [sic] the

prior art in terms of patentability." Office Action, at 7.

In any event, there is a functional relationship between the alleged "descriptive

material" and the elements of claim 1. The method of claim 1 recites specific operations that are

performed on, and because of, specific types of documents and messages. For example, if the

stored document were not an invention disclosure, there would be no need to generate a message

requesting approval to prepare a patent application from the invention disclosure—indeed, such

an element would be nonsensical. Accordingly, the Office is not entitled to disregard the

specific types of documents and data recited in claim 1, and the office action does not even assert

that Ashby discloses these recitations. Hence, Ashby fails to teach or suggest the elements of

claim 1 for which it is cited. The other cited reference, Microsoft, fails to supply the disclosure

missing from Ashby, and the office action therefore fails to establish a prima facie case that claim 1 is unpatentable over the combination of Ashby and Microsoft.

Similarly, the office action fails to establish a prima facie case that either claim 13 or claim 14 is unpatentable over the combination of Ashby and Microsoft. For example, claim 13 recites "storing a first workflow rule on a server system," "receiving, at said server system, a first signal from a first client system indicating a request to solicit comments on said draft patent application," and "executing said first workflow rule from said server system to generate a message requesting comments on said draft patent application from a second client system and communicate said message to said second client system." Ashby teaches none of these elements, and as noted above, the office action's attempt to avoid addressing these elements by dismissing them as descriptive material is improper. Claim 13, therefore, is believed to be allowable over the combination of Ashby and Microsoft as well.

Claim 14, for its part, recites "allow[ing] a first client system to set-up workflow rules that define, for predetermined events, selected client systems for said server system to transmit messages to, a workflow comprising one or more tasks to be completed by said selected client systems, times for completion of the one or more tasks, and times for sending reminders to said selected client systems." The office action fails even to address this element, but instead appears to construe the element as "storing a workflow rule." Even assuming Ashby did teach storing a workflow rule (which it does not), Ashby still would fail to teach or suggest allowing a client system to set-up such a workflow rule.

Claim 14 also recites "stor[ing], in said database, an invention disclosure submitted by a second client system." As noted above, Ashby contains no such teaching. In addition, claim 14 recites "transmit[ting] a message to a third client system to indicate that said invention disclosure has been stored in said database, wherein one of said predetermined events for which a workflow rule is defined is submission of an invention disclosure by said second client system and wherein said first client system defines said workflow rule to cause said server system to transmit said message to said third client system." The office action fails even to address this element, and a review of Ashby reveals nothing that appears to disclose this element.

For at least the reasons discussed above, independent claims 1, 13 and 14 are believed to be allowable over the combination of Ashby and Microsoft. It is believed, moreover, that the remaining cited references fail to remedy the failings of the Ashby/Microsoft combination, and that claims 1, 13, 14 therefore would be allowable over any combination of Ashby, Microsoft, Serbinis, Gross and Takano. Claims 2-12 and 15-17, which are rejected over various combinations of those references, therefore are believed to be allowable at least by virtue of their dependence from allowable base claims.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Dated: September 5, 2007   Respectfully submitted,

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